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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,840	09/11/2003	John S. Greeson	2166.07CIP	4829
30996	7590	11/30/2006	EXAMINER	
ROBERT W. BECKER & ASSOCIATES 707 HIGHWAY 333 SUITE B TIJERAS, NM 87059-7507			LEVY, NEIL S	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/659,840	Applicant(s) GREESON ET AL.	
	Examiner NEIL LEVY	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1615

DETAILED ACTION

In view of the appeal brief filed on 9/14/06, PROSECUTION IS HEREBY REOPENED.

new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:


ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1615

Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no basis in the specification for support for non-systemic effects. There is a postulated basis for presumption of a reduced degree of transdermal effects, based on the presence of emulsifiers in prior art application, which are not intended here. The instant carrier is, according to the summary, differentiated from prior known products by essentially (not further explained) no surfactant present in the carrier mixture. The instant viscosity of carrier is 120-1200 SUS at 100 degrees Fahrenheit; examples are to carriers of oil mixtures having unspecified additives or amounts thereof. We know not whether they are surfactant free, as carriers constituting 98+% of the total composition, but claims are simply to "essentially no surfactant"- so other materials-solvent, for example that can enhance transdermal penetration-are in fact permitted.

Organophosphates are well known as systematically effective as a chemical class. Claims to non-systemic pesticides, as in claim 12, are seen as contrary to the science. The composition claims recite that the pesticides act non-systematically, as shown in the prior art cited, but as written the claim also permits of systemic action. There is no disclosure or any data supporting non-systemic efficacy, and non-systemic host effects.

No single volatile compound is disclosed, as of claim 19, we don't know what was intended, & solvents are the most reasonable group to assume were intended.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 38 U. S. C. 112, the first paragraph have been described in *re Wands*, 8 USPQ2D 1400 (Fed Cir. 1988). Among these factors are (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims. (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that instant disclosure fails to meet the enablement requirement for the following reasons:

Art Unit: 1615

- (1) The nature of the invention: claims are to unqualified non-systemic effects.
- (2) The state of the prior art shows the use of these compounds with the same and similar specific carriers & pesticides.
- (3) The relative skill of those in the art. The relative skill of those in the art is high.
- (4) The predictability or unpredictability of the art. The unpredictability of the art is very high.
- (5) The breadth of the claims. The claims are very broad, as systemic effects can not be proven to have been performed, as opposed to topical effects, unless systemic data- blood or tissue sampling, were considered.
- (6) The amount of direction or guidance presented. There are none; or specific effects-the results expected are presumptive, no guidance given for determination if in fact the condition, infestation was actually not via systemic effects.
- (7) The presence or absence of working examples. There are none showing death of pests is caused by the treatment.
- (8) The quantity of experimentation necessary extensive- one has to show death & destruction by other than systemic effects.

Claim Rejections - 35 USC § 102

Claim 1-5, 9, 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by WALSTEIN- 4176076

No patentable weight is given to future intended use of the composition.

Although no animal use is expressed, the fluids are non-carcinogenic and free of ecological damage-an answer to the problem of prior lubricant skin exposure (column 1, lines 33-38; column 2, line 68) and provide pesticidal effectiveness at ½ to 1% (column 2, lines 48-49; column 3, top). Surfactants are common, but not required (column 5, lines 25-26). The carrier is mineral oil base, of oils of 70-800 SUS (column 5, lines 11-13). Example 1, oils of SUS 300 @ 67% and 75 SUS @ 25%; a mix resulting in 243 SUS. Example 3 provides another carrier, if given no viscosity to ester and

Art Unit: 1615

triethanolamine, of 198 SUS. If in contact with skin, the oil is that of the instant, the pesticides not, therefore, systemic.

Claim1-5,7,8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MALLIS et al 2988473

Claims 1-3 are met by Example V-oil carrier of 103 SUS is mixed with pesticidal dimethylsilicone, a non-systemic insecticidal effect results. Petroleum oils are stated to be well known carriers applied to livestock, to repel flies (column 1, lines 24-30). Auxiliary toxicants include pyrethroids and pyrethrin (column 1, lines 35-41); and organophosphates-parathion (column 3, lines 63-65). The oil as described at Example 5 is considered to be the instant mineral oil, not otherwise defined.

Claim1-3, 5, 7-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over b COFFEE et al 4316914 as explained by centistokes to SUS conversion table (Velcon 2003).

Giving no patentable weight to future intended use, the instant composition is shown, permethrin pesticide in carrier with resultant viscosity of 1-50 centistokes are taught (column 2, lines 28-37). 50 centistokes is shown to equate to 230 SUS. Example 1 provides 100 SUS (21.2 centistokes). Example 8 with a volatile compound armasol and Example 9, have viscosities of 230 SUS and 190 SUS respectively (50 and 43 centistokes). The instant claim10 is obvious, as Cerechlor.(column 3, lines 10-19) with viscosity of 100 (480 SUS) would, when mixed as taught permit whatever viscosity desired.

Claim1, 3, 5, 9, 10, 12, 14, 16, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by LEWER et al 6455504

Spinosyns as insecticides effective against flies when applied topically to animals, the instant method, is at (column 14, lines 34-38 and column 17, line39 and column 18, line 13) applied as is known in the art (column 19, bottom; column 20, top). Exemplary formulations are topically applicable to humans, thus, systematically ineffective (column 20, line 42; column 21, line 50) as shampoos with silicones, as carriers, of from 100 centipoise to 150,000,000, thus, within the range of the instant carrier viscosity.

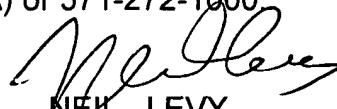
Art Unit: 1615

Arguments of the appeal brief of 9/14/06 have been considered, and rejection have been withdrawn in consideration of the arguments over FISHBEIN, and of GORDON after examination of centistoke to SUS conversion tables. The 112 second paragraph rejection is also withdrawn.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL LEVY whose telephone number is 571-272-0619. The examiner can normally be reached on Tuesday-Friday, 7 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


NEIL LEVY
Primary Examiner
Art Unit 1615